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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

1001.2350101

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on DECEMBER 11, 2008

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Typed or printed name THU H. LE-TO

Application Number

10/799,094

Filed

MARCH 12, 2004

First Named Inventor

LIXIAO WANG

Art Unit

3768

Examiner

ELLSWORTH WEATHERBY

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. ☒

This request is being filed with a notice of appeal. ☒

The review is requested for the reason(s) stated on the attached sheet(s). ☒
Note: No more than five (5) pages may be provided.


I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 41,376

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____


Signature

J. SCOT WICKHEM

Typed or printed name

612.677.9050

Telephone number

12-11-2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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P A T E N T

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	LIXIAO WANG et al.	Confirmation No.:	7638
Serial No.:	10/799,094	Examiner:	Ellsworth Weatherby
Filing Date:	MARCH 12, 2004	Group Art Unit:	3768
Docket No.:	1001.2350101	Customer No.:	28075
Title:	MRI AND X-RAY VISUALIZATION		

PRE-APPEAL CONFERENCE BRIEF

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Thu H. Le-To

DECEMBER 11, 2008

Date

Dear Sir:

Appellants have carefully reviewed the Final Office Action of June 11, 2008. Currently, claims 1-64 are pending and have been twice rejected. An after-final response was filed October 10, 2008. Appellants hereby request a pre-appeal conference and file this pre-appeal conference brief concurrently with a Notice of Appeal. Favorable consideration of the claims is respectfully requested.

Claims 1-64 were variously rejected under 35 USC 103(a) as being unpatentable over Griffin et al., US publication number 2004/0193140 (hereinafter "Griffin"). Ten separate rejections were made over various of claims 1-64 with Griffin as the primary reference. Appellants appeal these rejections because Griffin et al. is not available as prior art.

Griffin, which published September 30, 2004 (after the March 12, 2004 filing date of the present application), is available as a reference only under one or more of subsections (e), (f), and (g) of section 102. Both Griffin and the present application were, at the time the claimed invention was made, owned by the same person or subject to an obligation of


assignment to the same person and therefore, under 35 USC 103(c), Griffin is not available as prior art under 35 USC 103. As can be seen in the patent assignment database, the present inventors assigned their interest Scimed Life Systems, Inc. at reel 014716, frame 0109, which name was subsequently changed to Boston Scientific Scimed, Inc. at reel 018505, frame 0868. Likewise, the inventors of the Griffin application assigned their interest to Scimed Life Systems, Inc. at reel 013916, frame 0233, which name was subsequently changed to Boston Scientific Scimed, Inc. at reel 018505, frame 0868. Because Griffin et al. is not available as prior art for these rejections, no prima facie case of obviousness has been made and claims 1-64 are in condition for allowance.

For at least the reasons mentioned above, all of the pending claims are allowable over the cited prior art. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,
LIXIAO WANG et al.

By their Attorney,

Date: 12-11-2008



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